

### **REMARKS**

The Office Action dated December 11, 2008, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

By this Response, claims 10 and 13 have been amended to more particularly point out and distinctly claim the subject matter of the present invention. Claim 20 has been cancelled without prejudice or disclaimer. Claims 1-9 were previously withdrawn in Applicants' Response filed on February 11, 2008. No new matter has been added and no new issues are raised which require further consideration and/or search. Support for the above amendments is provided in the Specification at least on page 17, lines 3-13. Accordingly, claims 10-19 and 21 are currently pending in the application, of which claim 10 is the only independent claim. Applicants request entry of the above amendments because the above amendments place the claims in better condition for allowance.

In view of the above amendments and the following remarks, Applicants respectfully request reconsideration and timely withdrawal of the pending rejections to the claims for the reasons discussed below.

#### ***Claim Rejections under 35 U.S.C. §103(a)***

The Office Action rejected claims 10-21 under 35 U.S.C. §103(a) as being allegedly unpatentable over Lee (U.S. Patent Plant No. 10,438) ("Lee") in view of Pryor

(“Hybridization Between Evergreen and Deciduous Azaleas,” Quarterly Bulletin of the American Rhododendron Society, 1973, Vol. 27, No. 4, pp. 212-214) (“Pryor”), and further in view of Tamura, *et al.* (April 1989, “Hirado Tsutsuji no Saibai to Yurai,” Kurume no Tsutsuji, Ashi Shobo, pp. 153-162, pp. 157-158 in English) (“Tamura”). Applicants respectfully submit that the claims recite subject matter that is neither disclosed nor suggested in the combination of Lee, Pryor, and Tamura.

Claim 10, upon which claims 11-19 and 21 depend, recites a method. The method includes introducing a genotype from an azalea comprising an ever-flowering property into a deciduous, one season flowering azalea to breed an ever-flowering azalea. A selection of two different azaleas to cross breed is conducted by using a genotype which is an inheritance of main anthocyanidins, pelargonidin (Pgn), cyanidin (Cyn), and delphinidin (Dpn), concerning the exhibition of flower color.

As will be discussed below, Natsugari fails to disclose or suggest each and every element recited in claims 10-19 and 21, and therefore fails to provide the features discussed above. Claim 20 has been cancelled without prejudice or disclaimer.

Lee is directed to an evergreen azalea of the genus *Rhododendron* and a member of the *Ericaceae* family. The new azalea is referred to as ‘Conlea,’ which was discovered by Robert Edward Lee in October 1985 in Independence, La. ‘Conlea’ originated from a planned cross hybridization between two selected breeding lines in a controlled breeding program in Independence, La. The value of this new cultivar lies in its unique blooming period, bloom color, bloom form, and growth habit (Lee, Background of the Invention).

Pryor is directed to a hybridization between evergreen and deciduous azaleas (Pryor, Abstract). Tamura is directed to Hirado azaleas (Tamura, pages 153-162).

Tamura is directed to Hirado azaleas (Tamura, pages 153-162).

Assuming *arguendo* that the teachings of Lee could be combined with the teachings of Pryor and Tamura, the combination of Lee, Pryor, and Tamura would fail to disclose or suggest each and every element recited in claim 10. Specifically, the combination of Lee, Pryor, and Tamura would fail to disclose or suggest, at least, “wherein a selection of two different azaleas to cross breed is conducted by using a genotype which is an inheritance of main anthocyanidins, pelargonidin (Pgn), cyanidin (Cyn), and delphinidin (Dpn), concerning the exhibition of flower color,” as recited in claim 10.

The Office Action alleged that “the azaleas used by Lee had red flowers, a color that would have been produced by the presence of pelargonidin (an orange/red pigment), cyanidin (a red/orange pigment) and/or delphinidin (a blue pigment in a basic environment or a red pigment in an acidic environment). The Office Action further alleged that azaleas are typically grown in acidic soils (See Office Action on page 4). However, upon review of the teachings of Lee, Applicants respectfully submit that Lee fails to explicitly teach such a genotype. Thus, the Office Action alleged that Lee *inherently* teaches “a genotype which is an inheritance of main anthocyanidins, pelargonidin (Pgn), cyanidin (Cyn), and delphinidin (Dpn), concerning the exhibition of flower color.”

In relying upon the theory of inherency, the Office Action must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. *Ex parte Tanksley*, 37 USPQ2d 1382, 1385 (Bd. Pat. App. & Int’f 1994). Further, MPEP §2112 states that “To establish inherency, the extrinsic evidence, “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill in the art.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d, 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).”

The Office Action failed to provide a basis in fact and/or technical reasoning to reasonably support the determination that the properties for the genotype recited in claims 10-19 and 21 are inherent characteristics that necessarily flow from the teachings taught in Lee. Pryor and Tamura fail to cure the deficiencies of Lee. Therefore, the Office Action failed to meet its burden of illustrating that the characteristics of the genotype, as recited in claim 10, are inherent from the teachings of Lee, Pryor, or Tamura.

Therefore, Applicants respectfully submit that the combination of Lee, Pryor, or Tamura would fail to disclose or suggest each and every element recited in claim 10.

Claims 11-19 and 21 depend from claim 10. Accordingly, claims 11-19 and 21 should be allowable for at least their dependency upon an allowable base claim, and for the specific limitations recited therein. Claim 20 has been cancelled without prejudice or disclaimer.

Therefore, Applicants respectfully request withdrawal of the rejections of claims 10-21 under 35 U.S.C. §103(a) and respectfully submit that claim 10, and the claims that depend therefrom, are now in condition for allowance.

### **CONCLUSION**

In conclusion, Applicants respectfully submit that the teachings of Lee, Pryor, and Tamura, whether taken individually or in combination, fail to disclose or suggest each and every element recited in claims 10-19 and 21. The distinctions previously noted are more than sufficient to render the claimed invention non-obvious. It is therefore respectfully requested that all of claims 10-19 and 21 be allowed, and this present application be passed to issuance.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicants' undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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